



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,049	07/07/1999	HIROSHI MURAKAMI	31050.1US01	6168

20985 7590 02/10/2005

FISH & RICHARDSON, PC  
12390 EL CAMINO REAL  
SAN DIEGO, CA 92130-2081

EXAMINER
----------

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/349,049

Applicant(s)

MURAKAMI ET AL.

Examiner

Robert W. Morgan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9,11,13,14,16-25,27,29,30 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9,11,13,14,16-25,27,29,30 and 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/3/04, 10/14/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Notice to Applicant*

1. In amendment filed 4/21/04 in paper number 23, the following has occurred: Claims 1, 5, 13, 14, 20, 29 and 30 have been amended and claims 10, 12, 15, 26, 28 and 31 have been canceled. Now claims 1-9, 11, 13, 14, 16-25, 27, 29, 30 and 32-35 are presented for examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-5, 9, 11, 13, 14, 16-21 and 25, 27, 29, 30 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,812,070 to Tagami et al. in view of "Station Car EV Could Meet State Mandates" by Environmental Information Network, Inc. (hereinafter "EIN").

As per claim 1, Tagami et al. teaches a vehicle sharing system, comprising:

--the claimed at least one port including a parking space and a terminal for accepting as request to use a vehicle is met by the main port (MP, Fig. 4) that has a storage area, charging area, renting area and returning area as well as computer (60, Fig. 4) connected to user interface (48, Fig. 4) that allow potential users to request the usage of a vehicle (see: column 5, lines 2023, 46-53); and

Art Unit: 3626

--the claimed control center including a computer unit for processing said request is met by the main port (MP, Fig. 4), which holds computer (60, Fig. 4) that processes user information including requests for vehicles (see: column 5, lines 46 to column 6, lines 2);

Tagami et al. fails to teach the claimed allocating a vehicle based on an estimated distance and time duration of an intended trip in said request.

EIN teaches a station car concept for electric vehicles (EVs) where small EVs are available at transit stations and commuter who drive home, to work, to shop or to run errands, would rent the cars based on time and mileage (see: paragraph 2). The Examiner respectfully submits that vehicle allocation is generally done according to user preferences such as size, color, price etc... and allocating a vehicle based on an estimated distance and time duration is merely selecting a different user preference. This allows the control center computer described by Tagami to process the user information request and select the vehicle with enough charge to satisfy the intended trip.

One of ordinary skill in the art at the time the invention was made would have found it obvious to include renting vehicle based on time and mileage as taught by EIN within the vehicle sharing system as taught by Tagami et al. with the motivation of reducing the need for government to continually spend money on expanding our road systems and reducing the government subsidy of mass transit (see: EIN: paragraph 1).

As per claim 4, Tagami et al. teaches the claimed terminal including a display device and is programmed to display the identity of the allocated vehicle is met by computer (60, Fig. 4) and user interface (48, Fig. 4) which includes a display screen for providing vehicle information (see: column 5, lines 46-61).

As per claim 5, Tagami et al. a vehicle allocation system for allocating one or more vehicles from a fleet of vehicles to one or more users, the vehicle allocation system comprising:

--the claimed one or more ports at geographically remote locations relative to each other, each port having a user interface terminal for receiving user-input information is met by the main parking port (MP, Fig. 1) in a geographical region (G, Fig. 1) which have a control center (MC, Fig. 1) for processing user vehicle information (see: column 4, lines 1-12);

--the claimed at least one central station computer system coupled for communication with the user interface terminal at each port for receiving user-input information from any of said user interface terminals, wherein said at least one central station computer system is programmed to select and allocate a vehicle from the fleet in response to receiving user-input information from a user, said selection being based on the received user-input information is met by the main port (MP, Fig. 1) which holds computer (60, Fig. 4) that includes users interface (48, Fig. 4) that processes user information and select a vehicle (see: column 5, lines 34-36 and 46 to column 6, lines 2). In addition, Tagami et al. teaches user's usage records which indicate shortest and longest travel routes to expected destination from the main port (MP, Fig. 1) (see: column 8, lines 27-34). Furthermore, Tagami et al. teaches those registered users who want to rent a motor vehicle insert (reads on "user-input information") their own IC card in a card slot (48, Fig. 4) (see: column 5, lines 40-43).

Tagami et al. fails to teach the claimed received user-input information, wherein the received user-input comprises a desired time duration regarding the user's intended trip.

EIN teaches a station car concept for electric vehicles (EVs) where small EVs are available at transit stations and commuter who drive home, to work, to shop or to run errands,

Art Unit: 3626

would rent the cars based on time and mileage (see: paragraph 2). The Examiner respectfully submits that vehicle allocation is generally done according to user preferences such as size, color, price etc... and allocating a vehicle based on an estimated distance and time duration is merely selecting a different user preference. This allows the control center computer described by Tagami to process the user information request and select the vehicle with enough charge to satisfy the intended trip.

The motivation for combining the teachings of EIN within the system taught by Tagami et al. are discussed in rejection of claim 1, and incorporated herein.

As per claim 9, Tagami et al teaches the claimed port includes a display device to display the identity of the allocated vehicle to a user that inputs request information is met by the main port (MP, Fig. 1), computer (60, Fig. 4) and user interface (48, Fig. 4) which includes a display screen for providing vehicle information (see: column 5, lines 46-61).

As per claim 11, Tagami et al. teaches the claimed user-input information comprises distance information corresponding to a distance which the user desires to travel with one of the vehicles from the fleet of vehicles is met (see: column 5, lines 21-23, 62 to column 6, lines 2).

As per claim 13-14, Tagami et al. teaches the claimed user-input information further includes destination port information for identifying the destination port and wherein said desired time duration and said distance information comprise information corresponding to the time and distance beyond the time and distance required to reach the destination port is met by user's usage records which indicate shortest and longest travel routes to expected destination from the main port (MP, Fig. 1) (see: column 8, lines 27-34).

As per claim 16, Tagami et al. teaches a vehicle allocation system, wherein the vehicles in the fleet of vehicles are electric powered and each vehicle defines a state of charge (SOC) at any given time, the vehicle allocation system further comprising:

--the claimed plurality of vehicle computer systems associated on a one-to-one basis with the vehicles from the pool of vehicles, each vehicle computer system including means for detecting the SOC of its associated vehicle and for communicating a detected SOC to said at least one central station computer is met by the user interface (48, Fig. 4) communicating travel information to computer (60, Fig. 4) to assist in selecting a motor vehicle (C) with sufficient charge to complete the desired trip (see: column 5, lines 46-48, lines 69 to column 6, lines 2),

--the claimed at least one central station computer system is programmed to further base the selection of a vehicle on the detected SOC's of any vehicles located within the VSG of a port from which user-input information is received is met by the user interface (48, Fig. 4) communicating travel information to computer (60, Fig. 4) to help select a motor vehicle (C) from the pool of vehicles with sufficient charge to complete the desired trip (see: column 5, lines 46-48, lines 67 to column 6, lines 2).

As per claim 17, Tagami et al. teaches:

--the claimed port has a vehicle search group (VSG) in which more than one and less than all of the vehicle from the fleet may be located at any given time is met by the storage area (41) at the main port (MP, Fig. 1) that hold the vehicles in which the user travel information has selected to complete the desire trip (see: column 5, lines 60-67); and

--the claimed central station computer is programmed to select and allocate a vehicle from the VSG of the port from which user-input information is received is met by the computer

Art Unit: 3626

(60, Fig. 4) communication with user's interface (48, Fig. 4) to select the appropriately charged vehicle to complete the desired trip (see: column 5, lines 62 to column 6, lines 2).

As per claim 18, Tagami et al. teaches the claimed port includes a vehicle parking facility at which one or more vehicles may be parked at any given time and the VSG of a given port includes vehicles parked at a parking facility at the port is met by the vehicles parked in the storage area (41) at the main port (MP, Fig. 1) (see: column 5, lines 27-31, 41-47).

As per claim 19, Tagami et al. teaches the claimed VSG of a given port further includes vehicles due to arrive at the port within a preset time period is met by the returning procedure which includes all vehicle returning to main port (MP, Fig. 1) within a certain time period (see: column 5, lines 31-33).

As per claim 20, Tagami et al. teaches a method for allocating one or more vehicles from a fleet of vehicles to one or more users, the method comprising:

- the claimed providing at least one port terminal, each having a user interface for receiving vehicle requests from users is met by the main port (MP, Fig. 1) with user interface (48, Fig. 4) needed for receiving user travel requests (see: column 8, lines 27-34);

- the claimed receiving a request for a vehicle at one of said port terminals from one of said users, said request including user-input information is met ( see: column 8, lines 27-34); --  
the claimed communicating the user-input information to a central computer system is met by the computer (60, Fig. 4) that includes users interface (48, Fig. 4) that processes user information and selects the vehicle best equip to handle the intended trip (see: column 5, lines 34-36 and 46 to column 6, lines 2);



Art Unit: 3626

--the claimed selecting a vehicle from the fleet and allocating the vehicle to the request, said selection being based, at least in part, on a destination port and the user-input information received at that port terminal is met by selecting the appropriate vehicle for the trip according the user's travel record which includes time and distance information (see: column 5, lines 21-23, 62 to column 6, lines 2).

In addition, Tagami et al. teaches those registered users who want to rent a motor vehicle insert (reads on "user-input information") their own IC card in a card slot (48, Fig. 4) (see: column 5, lines 40-43).

Tagami et al. fails to teach the claimed user-input information regarding the user's intended trip received at that port terminal, wherein the user-input information comprises desired time duration.

EIN teaches a station car concept for electric vehicles (EVs) where small EVs are available at transit stations and commuter who drive home, to work, to shop or to run errands, would rent the cars based on time and mileage (see: paragraph 2). The Examiner respectfully submits that vehicle allocation is generally done according to user preferences such as size, color, price etc... and allocating a vehicle based on an estimated distance and time duration is merely selecting a different user preference. This allows the control center computer described by Tagami to process the user information request and select the vehicle with enough charge to satisfy the intended trip.

The motivation for combining the teachings of EIN within the system taught by Tagami et al. are discussed in rejection of claim 1, and incorporated herein.

As per claim 21, Tagami teaches the claimed step of providing at least one port terminal comprises locating a plurality of port terminals at geographically remote locations relative to each other, wherein each port terminal is coupled for communication with the central computer system is met by the user interface (48, Fig. 4) at the main port (MP, Fig. 1) in different geographical regions (G, Fig. 1) used for receiving IC cards with user's travel information (see: column 4, lines 65-67 and column 5, lines 40-49).

As per claim 25, Tagami et al. teaches the claimed step of displaying the identity of a selected vehicle on a display device at the port terminal, to inform the user of the selected vehicle is met by the main port (MP, Fig. 1), computer (60, Fig. 4) and user interface (48, Fig. 4) which includes a display screen for providing vehicle information (see: column 5, lines 46-61).

As per claim 27, Tagami et al. teaches the claimed user-input information comprises distance information corresponding to a distance which the user desires to travel with one of the vehicles from the fleet is met (see: column 5, lines 21-23, 62 to column 6, lines 2).

As per claim 29-30, Tagami et al. teaches the claimed user-input information further includes destination port information for identifying the destination port and wherein said desired time duration and said distance information comprise information corresponding to the time and distance beyond the time and distance required to reach the destination port is met by user's usage records which indicate shortest and longest travel routes to expected destination from the main port (MP, Fig. 1) (see: column 8, lines 2734).

As per claim 32, Tagami et al. teaches the claimed vehicles in the fleet of vehicles are electric powered and each vehicle defines a state of charge (SOC) at any given time, the method further comprising detecting the SOC of vehicles in the fleet of vehicles and wherein said step of

Art Unit: 3626

selecting a vehicle based on the user-input information received at the port terminal comprises further basing the selection on the detected SOC's of the vehicles is met by the user interface (48, Fig. 4) at the main port (MP, Fig. 1) communicating travel information to computer (60, Fig. 4) to assist in selecting a motor vehicle (C) from the pool of vehicle with sufficient charge to complete the desired trip (see: column 5, lines 46-48, lines 69 to column 6, lines 2).

As per claim 33, Tagami et al. teaches:

--the claimed defining a vehicle search group (VSG) for the port terminal at which user input information is received from a user, wherein more than one and less than all of the vehicle from the fleet may be located in the VSG at any given time is met by the storage area (41) at the main port (MP, Fig. 1) that holds vehicles in which the user information has selected to complete the desire trip (see: column 5, lines 60-67);

--the claimed wherein said step of selecting a vehicle from the fleet comprises selecting a vehicle from the VSG of the port at which user-input information is received from a user is met by the computer (60, Fig. 4) communication with user's interface (48, Fig. 4) to select the appropriately charged vehicle to complete the desired trip (see: column 5, lines 62 to column 6, lines 2).

As per claim 34, Tagami et al. teaches the claimed VSG of any given port terminal includes vehicles parked at a parking facility at the port terminal is met by the vehicles parked in the storage area (41) at the main port (MP, Fig. 1) (see: column 5, lines 27-31, 41-47).

As per claim 35, Tagami et al. teaches the claimed VSG of any given port terminal further includes vehicles due to arrive at the port terminal within a preset time period is met by the

Art Unit: 3626

returning procedure which includes all vehicle returning to main port (MP, Fig. 1) within a certain time period (see: column 5, lines 31-33).

4. Claims 2-3, 6-8 and 22-24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,812,070 to Tagami et al. and "Station Car EV Could Meet State Mandates" by Environmental Information Network, Inc. (hereinafter "EIN"), as applied to claims 1, 5, and 20 above and further in view of U. S. Patent No. 5,726,885 to Klein et al.

As per claim 2, Tagami et al. and EIN fails to teach a terminal including a display of a map of a serviced area, and said estimated distance of an intended trip is indicated by selection of a zone defined in said map.

Klein et al. teaches a vehicle map display for the user to assist location and current position of the vehicle.

Although Tagami et al. and EIN fail to teach a terminal including a display of a map of a serviced area, and said estimated distance of an intended trip, it would have been obvious to one having ordinary skill in the art to incorporate a map system as shown by Klein et al. in the vehicle system as taught by Tagami et al. with the motivation of assisting the user's in completing a more secure and safer desired trip (see: column 7, lines 17-22).

As per claim 3, Tagami et al. teaches the claimed shared vehicle is provided with a GPS which provides location information to a vehicle operator according to the selection of the zone when making the request is met (see: column 3, lines 24-26).

As per claim 6, Tagami et al. and EIN fail to teach a user-interface terminal comprises a display device for displaying a map to the user and a user-display interface for receiving user selected map locations corresponding to locations on the displayed map from a user.

Art Unit: 3626

Klein et al. teaches a vehicle map display for the user to assist location and current position of the vehicle.

Since Tagami et al. and EIN fail to teach a user-interface terminal and a user-display interface for receiving and displaying user information on map location, it would have been obvious to one having ordinary skill in the art to incorporate a map system as shown by Klein et al. in the vehicle system as taught by Tagami et al. and EIN the motivation being to better provide directional information to assist the user of the vehicle in finding the most efficient route to their destination.

As per claim 7, Tagami et al. and EIN fail to teach:

--the claimed computer programmed to control the display device to display a map with at least one of predefined zones and map locations; and

--the claimed user interface device for allowing a user to select at least one of the predefined zones and locations.

Klein et al. teaches a vehicle map display for the user to assist location and current position of the vehicle.

Although Tagami et al. and EIN fail to teach a computer program to control the display and user interface device for predefined zones and locations, it would have been obvious to one having ordinary skill in the art to incorporate a map system as shown by Klein et al. in the vehicle system as taught by Tagami et al. with the motivation of assisting the user's in completing a more secure and safer desired trip (see: column 7, lines 17-22).

Art Unit: 3626

As per claim 8, Tagami et al. teaches the claimed user interface device comprises at least one of a touch-screen, a keyboard, or a cursor controller is met by the user interface (48, Fig. 4) with keyboard (48b, Fig. 4) used to enter user password (see: column 5, lines 40-45).

As per claim 22, Tagami et al. and EIN fail to teach a method of receiving a request for a vehicle comprises:

- the claimed displaying a map to the user; and
- the claimed receiving user-selected map locations corresponding to locations on the displayed map through a user-interface associated with the displayed map.

Klein et al. teaches a vehicle map display for the user to assist location and current position of the vehicle.

Although Tagami et al. and EIN fail to teach displaying a map and receiving the user-selected map location, it would have been obvious to one having ordinary skill in the art to incorporate a map system as shown by Klein et al. in the vehicle system as taught by Tagami et al. and EIN. The motivation being to provide the user with better directional information to assist in finding a more efficient and timely route to their destination.

As per claim 23, Tagami et al. fails to teach a method of receiving a request for a vehicle comprises:

- the claimed displaying a map with at least one of predefined zones and map locations; and receiving user-selected zone or map locations through a user interface device.

Klein et al. teaches a vehicle map display for the user to assist location and current position of the vehicle.

Although Tagami et al. and EIN fail to teach displaying a map with at least one of predefined zones and map locations, it would have been obvious to one having ordinary skill in the art to incorporate a map system as shown by Klein et al. in the vehicle system as taught by Tagami et al. and EIN with the motivation of assisting the user's in completing a more secure and safer desired trip (see: column 7, lines 17-22).

As per claim 24, Tagami et al. teaches the claimed user interface device comprises at least one of a touch-screen, a keyboard, or a cursor controller is met by the user interface (48, Fig. 4) with keyboard (48b, Fig. 4) used to enter user password (see: column 5, lines 40-45).

#### ***Response to Arguments***

Applicant's arguments filed 4/21/04 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 4/21/04.

(A) In the remarks, Applicants argue in substance that, (1) The Examiner's rejections fails to establish a *prima facie* case of obviousness using three basic criteria (a) there must be some suggestion or motivation to combine or modify the references, (b) there must be a reasonable expectation of success, and (c) the prior art must teach or suggest each and every limitation of the claimed invention.

(B) In response to Applicant's argument that, (1) The Examiner's rejections fails to establish a *prima facie* case of obviousness using three basic criteria (a) there must be some suggestion or motivation to combine or modify the references, (b) there must be a reasonable expectation of success, and (c) the prior art must teach or suggest each and every limitation of the claimed invention. The Examiner respectfully submits that obviousness is determined on the

Art Unit: 3626

basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see: paper number 15).

As such, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257,



Art Unit: 3626

1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278

(CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Further, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the prior Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(C) In addition, it is respectfully submitted that the Examiner has applied new prior art to the amended features of claims 1, 5, 13, 14, 20, 29 and 30 at the present time. As such, Applicant's remarks with regard to the application of Tagami et al. DeLorme et al. and/or Klein et al. to the

Art Unit: 3626

amended claims are moot in light of the inclusion of the teachings of EIN, addressed in the above Office Action.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RWM  
rwm

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600